REMARKS/ARGUMENTS

The Office has required restriction of Claims 1-20 into the following groups:

Group I: Claims 1-10, drawn to a cell comprising three or more kinds of fusion genes of three or more different cell division proteins fused to three or more different fluorescent proteins.

Group II: Claims 11-14, drawn to a method of producing a stable cell division-visualized cell comprising (i) obtaining a fusion gene by allowing fusion of a gene of a protein that constitutes a cell structure which reflects the situation of a cell division, and a gene of a fluorescent protein, and (ii) introducing three or more kinds of said fusion genes.

Group III: Claims 15-20, drawn to a method of evaluating an influence upon cell division comprising (i) culturing a cell division-visualized cell, and (ii) carrying out the observation of the state of cell division by detecting fluorescence generated.

Applicants elect, with traverse, Group I (claims 1-10) for further prosecution. In addition, Applicants provisionally elect histone H3 and importin α (in Claims 3 and 9) and chromosome and nuclear membrane (in claims 2 and 8), all for examination purposes only. Claims 1-20 read on the elected species.

The Examiner has required restriction of original Claims 1-20 into the above groups, for the reasons noted on pages 2-4 of the present Office Action. In addition, the Examiner has asserted that the present application contains claims directed to patentably distinct species, as noted in the present Office Action on pages 5 and 6, and has thus required an election of species. Applicants note that the full scope of pending Claims 1-20 is broader than the Examiner's characterization of the sum of the respective claims in Groups I-III.

Applicants traverse the present Restriction and Election of Species Requirement, for the reasons noted below, based on the Examiner's remarks in the present Office Action. Applicants submit that, for at least the reasons presented below, the Office has failed to meet the burden necessary to sustain the Restriction and Election of Species Requirement, in reference to the claims as characterized in Groups I-III, and in reference to the full scope of the pending claims.

Applicants submit that the Office has not made a proper restriction. Restriction is only proper if the claims of the restricted groups are either independent or distinct. There also must be a serious burden on the Examiner if restriction is required. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion in support of restriction (see MPEP § 803). Applicants respectfully submit that the Office has not demonstrated that it would be a serious burden to examine the entire application.

In regard to the restriction between Groups II and I, the Examiner has characterized the inventions of these groups as related to a process of making and the product made. The Examiner generally asserted that, in the instant case, the cell comprising three or more kinds of fusion genes of three or more different cell division proteins, fused to three or more different fluorescent proteins, can be made by a materially different process, such as random integration of gene trap vectors, comprising three or more different fluorescent marker proteins, and wherein transcription of an endogenous gene results in the expression of a fusion protein of the endogenous gene and the fluorescent protein, and followed by selection for different targeting events, in different cell division proteins within the same cell. However, the Examiner did not provide any reasons or examples, in terms of, an example of such a process and the feasibility of such a process, for example, to support this statement, and to support a conclusion of restriction.

In regard to the restriction between Groups I and III, the Examiner has characterized the inventions of these groups are related as product and process of use. The Examiner generally asserted that, in the instant case, the cell comprising three or more kinds of fusion genes of three or more different cell division proteins, fused to three or more different fluorescent proteins, can be used in a materially different process, such as identification of transcription factors that regulate the expression of the promoters that are operably linked to the fusion protein genes. However, the Examiner did not provide any reasons or examples, in terms of, an example of such a process and the feasibility of such a process, for example, to support this statement, and to support a conclusion of restriction.

In regard to the restriction between Groups II and III, the Examiner has asserted that the inventions of these groups are biologically and functionally different and distinct. The Examiner generally asserted that the method of each respective group comprises steps, which are not required for, or present in, the method of the other group, such ás, obtaining a fusion gene by allowing fusion of a gene of a protein that constitutes a cell structure, which reflects the situation of cell division, and a gene of a fluorescent protein (Group II); and carrying out the observation of the state of cell division, by detecting fluorescence generated by allowing expression of said fluorescent proteins during cell division of a cell division–visualized cell (Group III). The Examiner also generally asserted that the end results of the methods are different, such as, the production of a stable cell division-visualized cell (Group II), and the evaluation of an influence upon a cell division (Group III). Thus, the Examiner concluded that the operation, function and effects of the respective methods are different and distinct, and these methods are capable of supporting separate patents. However, the Examiner did not provide any reasons or examples, in terms of, a description of such differences in the specific method steps for each method, for example, to support this statement, and to support

a conclusion of restriction. Applicants note that both methods use gene fusion, and relate to a cell division-visualized cell, and such is contrary to the Examiner's position for restriction.

Applicants submit that the Examiner's reasons regarding the burden associated with searching the inventions of Groups I-III, are based on the Examiner's arguments, as discussed above, and do not provide additional reasons and/or examples to support the restriction of these groups. Therefore, as discussed above, the Examiner has not supported a conclusion of restriction of Groups I-III.

The burden is on the Office to provide reasons to conclude that the inventions are patentably distinct, and not on the Applicants to establish that they are not. Therefore, the Office has not supported its conclusion of restriction of the respective groups, and has not shown that it would be a serious burden to search and examine the claims of Groups I-III together. Applicants respectfully submit that a search of all the claims, without further restrictions, would not impose a serious burden on the Office.

Applicants submit that if the product claims are allowable, the method claims should be rejoined under MPEP § 821.04, if the method claims depend on, or include all the limitations of, the allowed product claim(s). Rejoinder is applicable in this case. Applicants also submit that if the elected species are found allowable, the Office should conduct a search of the non-elected species.

Accordingly, for at least the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary, in order to sustain the Restriction and Election of Species Requirement in the present application. Applicants respectfully request the withdrawal of the Restriction and Election of Species Requirement.

Applicants respectfully submit that the present application is now in condition for examination on the merits, and request early notice of such action.

Respectfully submitted,

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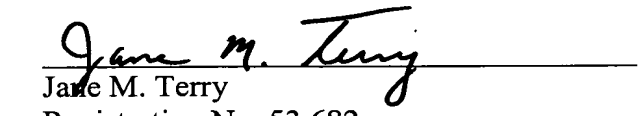

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